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In re Application of SIMOES	:	
U.S. Application No.: 09/766,485	:	DECISION ON PETITION
Int. Application No.: PCT/EP96/04945	:	
Int. Filing Date: 12 November 1996	:	UNDER 37 CFR 1.137(b)
Priority Date: none	:	
Attorney Docket No.: none	:	
For: INSTRUMENT FOR THE MEDICAL OR	:	
DENTAL TREATMENT OF CHILDREN	:	

This is in response to applicant's "Petition Under 37 CFR 1.137(b)" filed 19 January 2001.

### **BACKGROUND**

On 12 November 1996, applicant filed international application PCT/EP96/04945. A copy of the international application was communicated to the USPTO from the International Bureau on 22 May 1998. The twenty-month period for paying the basic national fee in the United States expired at midnight on 13 July 1998 (12 July 1998 was a Sunday).

International application PCT/EP96/04945 became abandoned as to the United States at midnight on 13 July 1998 for failure to pay the basic national fee.

On 18 August 1998, applicant filed United States national application number 09/135,486 under 35 U.S.C. 111.

On 04 April 2000, U.S. application number 09/135,486 issued as U.S. patent number 6,045,360.

On 19 January 2001, applicant filed the present reissue application number 09/766,485 along with the present petition under 37 CFR 1.137(b).

### DISCUSSION

Under 37 CFR 1.137(b)(3), the USPTO may require additional information where there is a question whether a delay was unintentional. A delay resulting from a deliberate course of action on the part of the applicant is not an "unintentional" delay within the meaning of 37 CFR 1.137(b). See MPEP 711.03(c), subsection III.C.1.

In the present case, the petition is accompanied by a copy of a letter dated 17 August 1998 which indicates that applicant's representative was made aware that international application PCT/EP96/04945 had become abandoned as to the United States for failure to timely enter the national stage. The petition is also accompanied by a copy of a letter dated 18 August 1998 which indicates that applicant's representative deliberately did not file national stage papers in the United States under 35 U.S.C. 371 (i.e. deliberately chose not to seek revival of the international application) and instead chose to file a United States national application under 35 U.S.C. 111 in order to delay payment of filing fees. It is noted that a delay resulting from a deliberately chosen course of action on the part of applicant does not become an "unintentional" delay within the meaning of 37 CFR 1.137(b) because the applicant simply seeks to defer payment of fees. See MPEP 711.03(c), subsection III.C.1. Because the failure to seek revival of the international application was a deliberate course of action, the delay was not "unintentional" under 37 CFR 1.137(b).

The "Statement of Inoperativeness or Invalidity of Original Patent" filed with the reissue application states that the present petition is necessary in order to remove a related German patent as prior art. In addition, the declaration of Felix D'Ambrosio states that the decision to file the application under 35 U.S.C. 111 instead of 35 U.S.C. 371 was made without knowledge of the German patent. However, an intentional delay resulting from a deliberate course of action is not affected by the correctness of the applicant's or applicant's representative's decision to abandon the application or not to seek revival of the application and is not affected by the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek revival of the application. See MPEP 711.03(c), subsection III.D. Thus, the fact that applicant may have become aware of the German patent's effectiveness as prior art does not affect the intentional failure to seek revival of the international application. Therefore, it would be inappropriate to conclude that the delay in entering the national stage in the United States under 35 U.S.C. 371 was unintentional within the meaning of 37 CFR 1.137(b).

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request

should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)". No additional petition fee is due. Extensions of time are NOT available under 37 CFR 1.136.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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